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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/734,886

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Urs Hoelzle

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EXAMINER

AMSBURY, WAYNE P

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/734,886

Applicant(s)

HOELZLE ET AL.

Examiner

Wayne Amsbury

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

CLAIMS 1-61 ARE PENDING

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. In response to the appeal brief of 12/5/05, an appeal conference was held 2/14/06 with Safet Metjahic and Charles Rones. It was decided that difficulties in claim interpretation rise to the level of 25 USC 112, first paragraph. Prosecution is hereby re-opened.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1-6 and 9-24 are rejected under 35 U.S.C. 112, first paragraph, as** failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The phrase: "*search object*" is not defined in the specification, and its relationship to highlighted characters is not set forth in an enabling manner. In the Brief, page 14 top, it is stated that the search object may or may not be dependent on the highlighted characters (of the claims), which leaves it to be anything.

Reference is made to page 12 of the Specification, where it is stated that a user may select a software button or menu item provided, perhaps, by a browser assistant. The term *search object* is not used in this discussion, and thus the connection of a browser assistant and/or buttons and menus to such a term is not made. Furthermore, these terms do not appear in the claims.

Claim 2 states that the *search object* may be **located** in a menu or toolbar, but does not explicate what it is *per se*, and the claim is not part of the Specification.

In summary, there is no viable guidance in the Specification to enable one skilled in the art to make and/or use the invention as claimed using this phrase.

**4. Claims 1-6 and 9-24 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is meant by *search object* in these claims, since it is not a term in the art and is not defined in the Specification. In the interest of compact prosecution, it is taken to mean any entity that might be used to initiate a search and/or any entity that might be the target object of a search, as needed.

**5. Claims 1-6 and 9-24 are rejected under 35 U.S.C. 112, second paragraph,** as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

The omitted structural cooperative relationships are: any relationship between *search object* and the highlighted groups of characters. As noted above, the Brief states that there may not be any, and in that case the role of the search object in the claims is unexplained, simply one of a list of unconnected elements.

6. Applicant's arguments with respect to claims 1-61 have been considered but are moot in view of the new ground(s) of rejection.

**7. Claims 1, 3-7, 9-12, 14-33 and 35-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Kleinberg, US 6,112,202, 29 August 2000.**

Kleinberg is directed to a method of searching for information in a network, particularly in hyperlinked environments such as the Web [COL 1 lines 8-15]. While the invention is primarily discussed as a method, it is supported by an apparatus that includes appropriate means for executing the method [COL 5 lines 26-33], and may be embodied as a computer program product [COL 5 lines 34-40].

**As to claim 20:**

*A system for receiving selection of one or more groups of characters in a document currently displayed to a user in response to the one or more groups of characters in the document being highlighted and a search object being selected while the one or more groups of characters in the document are highlighted;*

One object of Kleinberg is to search for resources such as Web pages that are linked with hyperlinks [COL 4 lines 11-16]. Kleinberg is an improvement on the background technology in which hyperlinks may be highlighted [COL 2 line 49 to COL 3 line 4]. A set of highlighted words, pictures or icons associated with hyperlinks corresponds to a search object that initiates a search [COL 2 lines 51-56]. So does a hyperlink embedded in a displayed and/or highlighted item such as a word, phrase, icon or picture [COL 1 lines 61-67].

*means for generating a search query using the selected one or more words;*

Kleinberg is directed to finding an initial set of P pages containing a query string, and then iterating the search to other pages linked to the set of P pages. This may be initiated by finding at least one page of interest [COL 4 lines 44-52; COL 7 lines 27-30], which corresponds to following any highlighted hyperlink on a Web page. Clicking on such a highlighted hyperlink corresponds to generating a search query for at least one page.

*means for obtaining search results based on the search query; and*

*means for providing the search results to the user.*

Returning one or more pages [FIG 1] corresponds to obtaining search results, and they may be displayed [COL 3 lines 13-18].

As to **claim 21**, the method of Kleinberg iterates the process to find linked pages [COL 4 lines 53-65], where pages are documents.

As to **claim 25**, determination of the start set (initial set of pages) in Kleinberg [COL 4 line 44] corresponds to prefetching documents associated with a search. Kleinberg counts links and determines scores for each stage of iteration [COL 4 lines 53-65]. As to **claim 26**, Web pages are documents and vice versa. As to **claim 27**, the hyperlinks on a Web page correspond to a list of links. As to **claims 28 and 29**, the iteration procedure of Kleinberg grows the set of pages returned [FIG 1] by finding documents linked to those already returned [COL 8 line 42 and after], which includes providing a prefetched document already found and providing one not yet found. As to **claim 30**, following the links to a Web page corresponds to doing an address lookup.

As to **claims 35 and 36**, the computation of hubs corresponds to determining the popularity of a linked document [COL 6 lines 30-49].

As to **claim 41**, the method of Kleinberg may limit the retrieved documents by returning only the k largest scores [FIG 1], which corresponds to using a threshold.

As to **claim 42**, the iteration module of Kleinberg corresponds to a browser assistant.

As to **claims 5-7**, Kleinberg is an improvement on the practice of using phrases as hyperlinks [COL 1 line 38; line 63; COL 2 line 64].

As to **claim 9**, a paragraph is merely an extended phrase, for which the dictionary meaning includes: a sequence of words expressed as a unit. A phrase may also be an entire document.

As to **claim 10**, words and phrases correspond to textual concepts.

As to **claim 11**, Kleinberg applies a vector space model [COL 8 line 43 and after].

The elements of **claims 1, 3-4, 12, 14-19, 22-24 and 31-33, 37-40 and 43-45** are rejected in the analysis above and these claims are rejected on that basis.

**8. Claim 2, 8, 13 and 34 and 46-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinberg, US 6,112,202, 29 August 2000.**

As to **claims 8 and 13**, Kleinberg does not address discarding words, particularly stop words, that are unnecessary for obtaining relevant results, but **it would have been obvious** for one of ordinary skill in the art at the time of the invention to do so because it is more efficient to omit unnecessary words.

As to **claim 2**, Kleinberg does not explicitly provide for a search object within a menu or toolbar. **Official Notice** is taken that it was well known at the time of the invention to provide a menu containing a list of the hyperlinks to most-recently visited Web sites within the toolbar of a browser. **It would have been obvious** to use such hyperlinks to initiate a search because the linked pages are have a high probability of content of interest and thus may be used to initiate a search in Kleinberg [COL 4 lines 30-33].

As to **claim 34**, Kleinberg does not explicitly apply clickthrough rates. **Official Notice** is taken that the clickthrough rate was a well-known measure of user interest at the time of the invention. Evidence for this is given by Wu et al, US 6,741,967 Table B COL 19], where such a rate is used as a measure of usability for advertisements.



The Specification of this application also teaches that it was well known in the art at the time of the invention [[page 17 line 15 to page 18 line 3].

**It would have been obvious** to one of ordinary skill in the art at the time of the invention to apply clickthrough rate to score documents because it is a useful measure of user interest.

As to **claim 46**, the list of most-recently visited Web sites corresponds to adding links to the Web page document being displayed. As to **claims 47-48**, such a visited page is a publication and a name, and includes a link associated with the name. As to **claim 49**, in cases where the link is to a commercial Web site, it links to related documents associated with producers, sellers, reviewers and the like.

The elements of **claims 50-61** are rejected in the analysis above and these claims are rejected on that basis.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 571-272-4015. The examiner can normally be reached on M-F 6-18:30 FIRST WEEK.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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